II. Claim rejections under 35 U.S.C. § 112, second paragraph

Claims 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention for the various reasons set forth on page 2 of the present Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, claims 7 and 8 recite "improper" Markush language. Applicant disagrees, and therefore respectfully traverses this reason for rejection.

The language "X is chosen from A, B, and C" is a proper alternative to Markush language and accurately describes the claimed invention, *i.e.,* the composition may contain X with each X independently selected from the group A, B, and C. For example, Applicant's claim language covers a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. Applicant respectfully submits that this claim language is clear, and the Examiner has shown no legal basis for requiring Applicant to change it.

Applicant directs the Examiner to an example of proper claim language set forth in the M.P.E.P: "wherein R^1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)." *See* M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition. Thus, the M.P.E.P. does not require the use of the language "selected from the group consisting of."

In light of the above example of proper claim language provided by the PTO, it is clear that there is no reason for the Examiner to require the Applicant to change the

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claim language of the pending claims. Accordingly, Applicant respectfully submits that this reason for rejection under 35 U.S.C. § 112, second paragraph, is in error, and requests that the rejection be withdrawn.

III. Claim rejections under 35 U.S.C. § 103(a)

Claims 1 - 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,093,108 to Pappas et al. ("*Pappas*") in view of U.S. Patent No. 5,212,214 to Kallenbach ("*Kallenbach*") for the reasons set forth on pages 3 - 4 of the present Office Action. Applicants respectfully traverse this rejection.

Pappas teaches quick drying nail enamel compositions. However, as acknowledged by the Examiner, *Pappas* does not teach microspheres. The Examiner relies on *Kallenbach* to remedy *Pappas*' deficiencies, asserting that "*Kallenbach* discloses a coating composition which is known in the art for enhancing hardness, abrasion-resistance and durability...[which] comprises ceramic microsphere." *See* page 4 of the present Office Action. The Examiner concludes that

> "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the coating composition comprising microspheres taught by *Kallenbach* in nail enamel composition [sic] taught by *Pappas*, with the expectation of achieving the same beneficial results. One would expect to obtain a coating compositon [sic] which exhibit [sic] the physical properties of enhanced durability, high gloss and abrasion."

See page 4 of the present Office Action. Applicants disagree.

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To establish a *prima facie* case of obviousness, the Examiner must demonstrate that there was some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings, and demonstrating that there was a reasonable expectation of success. *See* M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, the Examiner has failed to make a *prima facie* case of obviousness because at least these two criteria have not been met.

For at least the following reasons, one of ordinary skill in the art would not have been motivated to use *Kallenbach*'s composition in the nail enamel composition taught by *Pappas*. First, *Pappas* teaches a composition comprising a primary film forming polymer, a secondary film forming polymer, a plasticizer and a solvent system, whereas *Kallenbach* teaches a composition comprising an arylene sulfide polymer resin and a ceramic microsphere filler. Pappas does not teach an arylene sulfide polymer resin or microspheres. Second, *Pappas* teaches "quick drying nail enamel compositions which dry in a period no greater than three minutes" "at room temperature and a relative humidity of about 50 to 55%." *See* Abstract, col. 14, lines 29-32. In contrast, *Kallenbach* teaches a composition wherein "the polymer components are typically cured at a temperature in the range of from about 315^{0}C. to about 470^{0}C." *See* col. 9, lines 28-32. Finally, *Pappas* teaches compositions for application to nails, whereas

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Kallenbach teaches compositions for application to a suitable substrate, where "[s]uitable substrates...can be formed from any metal, glass, ceramic, or other material...which can withstand the temperature conditions required for curing the polymer component(s) of the inventive coating composition." *See* col. 9, lines 23-28.

Because *Pappas* and *Kallenbach* teach the use of different chemical compounds to form different products via different methods for different purposes, one of ordinary skill in the art would not have been motivated to combine their teachings in the manner suggested by the Examiner.

Further, one of ordinary skill in the art would not have had the requisite reasonable expectation for success for making the combination suggested by the Examiner. *Kallenbach* teaches that "the arylene sulfide polymer resin and the ceramic microsphere filler used in the inventive composition operate together in a synergistic manner to provide a surprisingly hard, abrasion resistant, and durable coating." *See* col. 1, line 55-59. This synergistic effect "is believed to result from the formation of chemical bonds between the arylene sulfide polymer resin and the ceramic microspheres." *See* col. 1, line 60-64. Specifically, "it is believed that sulfur-oxygen bonds are formed between the arylene sulfide polymer(s) and the ceramic microspheres when the inventive composition is cured" "typically...at a temperature in the range of from about 315^{0}C. to about 470^{0}C." *See* col. 2, lines 1-4, and col. 9, lines 28-32. Accordingly, one of ordinary skill in the art would not have had a reasonable expectation that this synergistic effect, which provides the "surprisingly hard, abrasion resistant, and

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durable coating," would be observed if the components were added to *Pappas'* compositions and were also not cured.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been made because the cited references fail to provide both a motivation to combine reference teachings and a reasonable expectation of success for making the proposed combination. Accordingly, for at least the foregoing reasons, Applicants respectfully request the withdrawal of this § 103(a) rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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